

REMARKS

Claims 1-17 are pending in this application. By this Amendment, paragraphs [0012], [0015], [0016], [0017], [0019], [0021], [0033], [0036], [0044], [0048], [0052], [0053], [0100], [0103], [0109],[0122], and [0126] of the specification are amended, and claims 1, 4, 5, 10, 12, 13 and 17 are amended. No new matter is involved

Initially, Applicants acknowledge with appreciation the courtesies extended by Examiners Lugo and Chilcot to Mr. Webster, their undersigned representative, during the personal interview held on November 18, 2003.

During that Interview, Examiner Lugo indicated that Applicants' proposed Amendments to claims 5 and 17, to the specification, and to the drawings were acceptable and overcame the objections to the drawings and to the specification, and overcame the rejection of claims 4, 5, 8, 9 and 17 under 35 USC §112, second paragraph.

This response constitutes Applicants' summary of the interview.

Although the amendments have been determined to overcome the aforementioned objections and rejections, Applicants summarize the changes made for the record.

In paragraph 2 on page 2, the Office Action objection to the drawings for the reason that reference character "15" has been used to designate different elements in Figs. 1 and 19 has been overcome by the amendment of Fig. 1 to change reference character 15 to reference character 10. Reference character 10 is not used elsewhere. The specification is also amended to correspond to the change in Fig. 1.

In paragraph 3 on page 2, the Office Action objection to the drawings because they include several specified reference signs not mentioned in the description has been overcome by amending reference sign 76, Fig. 35 to remove that reference character from the figures. Regarding reference sign CS, paragraphs [0015], [0016], [0017], [0019], [0021] and [0033] are amended to associate CS with cut sheet(s). Regarding reference signs S510, S527, S545,

S827 and S837, the specification is amended to clarify the originally filed disclosure that pertains to each of those reference numbers.

In paragraph 4 on page 2, the Office Action objection to the drawings because element S858 is not illustrated in the drawings has been overcome by amendment of the specification to correct the typographical error referring to element S858 instead of S853.

In paragraph 5 on page 2, the Office Action objection to the specification for three informalities has been overcome by amending the specification to change each of the three specified informalities as suggested by the Office Action.

Upon review of the Application after receiving the outstanding Office Action, Applicants realized that Fig. 7 is described in the Brief Description of the Drawings, but is not further described in detail in the specification. Accordingly, Applicants have amended paragraph [0044] of the specification to describe Fig. 7. No new matter is involved. The description of Fig. 7 in paragraph [0044] finds support in the Brief Description of Fig. 7 found on page 3 of the Specification and in Fig. 7, itself.

In response to the drawing objection regarding element 76 in Fig. 35, Applicants have amended paragraph [0126] to describe element 76. No new matter is involved. In Fig. 35, element 76 is located between CPU and wireless unit 77, which is disclosed on page 31, for example, as being structured in conformity with the short-range wireless data transmission standard, such as, Bluetooth to transmit voice and text data, as digital signals, from antenna 78.

Paragraph [0122] has been amended to replace the misspelled word "forth" with the correct spelling, i.e. , --fourth--.

In paragraph 7 on page 3, the Office Action rejects claims 4, 5, 8, 9 and 17 under 35 U.S.C. §112, second paragraph, as being indefinite. This rejection is respectfully traversed.

Regarding claim 4, it is respectfully asserted that claim 4 clearly refers to a personalized product, not to personalized product data.

Regarding claim 5, the Office Action indicates that it is unclear how the customer "designs" a personalized product producing devices location. However, it is noted that claim 5 does not contain any recitation of the word "design." Rather, claim 5 recites that certain things are "designated" according to the recitations in the claim. Though the word designated begins with the word design, it has a different meaning. Therefore, it is respectfully asserted that the Office Action has inadvertently misread the language of the claim. It is respectfully asserted that claim 5 as originally filed is clear and definite as required by 35 U.S.C. §112.

Regarding claim 17, the claim is amended to change its dependency from claim 2 to claim 12. It is respectfully asserted that claim 12 contain sufficient antecedent basis for the recitations of claim 17.

As noted above, Examiner Lugo has agreed that this rejection has been overcome.

In paragraphs 8-12 on pages 4-11, the Office Action details four discrete rejections of the claims. All four of these rejections rely on CurrentChecks.com as a reference alleged to be prior art.

A review of the references provided with the Office Action failed to discover a reference that appears on its face to correspond to the applied reference CurrentChecks.com. In a telephonic interview with the Examiner on September 22, 2003, Applicants' representative was informed that the asserted reference CurrentChecks.com corresponds to a reference provided with the application called "Checks Unlimited." It was further noted that the reference Checks Unlimited describes in the text on its first page that Checks Unlimited is the current name for a business entity previously called Current Checks.

This Checks Unlimited reference contains no indication of its publication date and, further, it is not a reference of record in the Office Action. Consequently, a subsequent

telephonic interview was conducted with the Examiner and the Examiner's supervisor, Judy Swan, on September 24, 2003.

This filing constitutes Applicants' written Interview Summary of the previously mentioned interviews. During the interviews, it was pointed out that the references supplied by the Office Action, particularly the reference alleged to be CurrentChecks.com, fail to demonstrate a publication date substantiating that the reference qualifies as prior art under any sub-section of 35 U.S.C. §102. Therefore, it was requested that documentation be provided authenticating the publication dates alleged for the Internet references of record.

In response to this request, an Interview Summary was provided on September 24, 2003, including three pages of attachments. It is alleged that the attached documents attached to the Interview Summary substantiate the publication date for the Internet references of record, including those applied in the Office Action in rejecting the claims. However, it is respectfully asserted that a *prima facie* case has not been established that a reference CurrentChecks.com was published on March 8, 2000 as alleged in the Notice of References cited attached to the Office Action. Rather, none of documents attached to the Interview Summary on September 24 correspond to the reference CurrentChecks.com.

During the interview on September 22, 2003, it was observed that the reference entitled "Checks Unlimited" on its face switches within to a reference that corresponds more directly to CurrentChecks.com. It was further observed that each page of the reference contains a URL listing in the lower left-hand corner, to the extent that these URL listings can be read in the copy of the reference that was provided with the Office Action.¹ It was further

¹ The URL listings in the lower left-hand corner are not legible in each page of each reference. Rather, most of the URL listings are illegible. Therefore, it is respectfully requested that supplemental copies of the references be provided having a legible URL on every page with the next Office Action.

asserted that the publication date for a given URL is embedded in a string of numerical characters in a URL that appears in the lower left-hand corner of each page of each reference.

Regarding the "Checks Unlimited" reference, the first page does not contain any numerical characters in the URL at the lower left-hand corner. The second page of that reference contains a string of characters that, to the best those characters can be read in the illegible copy provided with the Office Action, read, 20000308123451. The numerical string of characters on the third page of the reference read, to the best those characters can be read on the illegible copy provided with the Office Action, 20000306115433.

Even assuming *arguendo* that a string of numerical characters in a footnote URL constitutes a publication date for a reference, an assumption that has not been established sufficiently to satisfy a *prima facie* case, the reference alleged to correspond to CurrentChecks.com is internally inconsistent. Applying the foregoing assumption, the first page of the reference has no publication date, and the second page of the reference has a publication date different than the third page of the reference. The string of numerical characters in the URL are different for each of the first three pages of the "reference."

It is respectfully submitted that this morass of confusion utterly fails to establish a clear *prima facie* case of a publication date for the reference referred to as CurrentChecks.com in the various prior art rejections of the claims.

It was further asserted during the interview on September 22, 2003 that an actual date of publication can be extracted from the string of numerical characters appearing in the URL of each page of the references according to the following format: the first four numbers are the publication year; the next two numbers are the publication month; and the two numbers following the publication month are the publication day. It was asserted that the string of numbers that continue in each URL are superfluous and should be ignored. Assuming *arguendo* that this convention for establishing a publication date of an Internet reference has

been established sufficient to constitute a *prima facie* case for the publication dates attributed to the Internet references of record in the Office Action, which it has not, the publication date for pages 3-8 of the CurrentChecks.com reference is not the publication date attributed to it in the Office Action. Further, in the same manner previously discussed in connection with page 1 of this "reference", pages 9 and 10 of the reference also do not have a publication date.

In the interview on September 24, 2003, it was explained that these Internet references are obtained in connection with a web site having the URL archive.org, also known as the "Way Back Machine." It was further explained that by entering a given URL in a search dialog box, the Way Back Machine returns a chart showing publication dates archived by the Way Back Machine for that URL. It was further represented that a copy of such a chart should be provided with each Internet reference and that this chart establishes a publication date for the reference when a date embedded in the URL in the footer of the reference corresponds to a date listed on the chart provided with the reference according to the previously described date convention.

However, no date on any of the charts provided with the Interview Summary corresponds to the date provided with pages 3-8 of the CurrentChecks.com "reference". Rather, only page 2 has both a URL and a date corresponding to the authentication pages provided with the Interview Summary. Therefore, the rejections will be treated as if the CurrentChecks.com reference constitutes page 2 of the ChecksUnlimited.com reference, and nothing more.

The other two Internet references provided with the Office Action, one of which is also applied in rejecting the claims, RubberStampsnow.com, suffer from similar defects and fail to establish a publication date sufficient to satisfy a *prima facie* case. For example, to the best that this information can be ascertained from the illegible URLs in the copy of the reference provided with the Office Action, the PrintUSA.com reference has two date codes

according to the previously described alleged date coding convention in the URL at the foot of various pages therein,. Neither of the two date codes in the URLs at the foot of the pages of the PrintUSA reference provided with the Office Action correspond to a date in the chart for the PrintUSA.com reference provided with the September 24 Interview Summary.

Regarding the RubberStampsnow.com reference, the URL in the footer of pages 3-5 of that reference is entirely illegible in the copy of the reference provided with the Office Action. Therefore, it has not been possible to evaluate the veracity of the publication date attributed to the reference in the Office Action according to the conventions described during the interviews.

In paragraph 9, beginning on page 4, the Office Action rejects claims 1-6 and 10-17 under 35 U.S.C. §103(a) as being unpatentable over RubberStampsnow.com (hereinafter "Rubber Stamp") in view of CurrentChecks.com (hereinafter "Current Checks") and further in view of U.S. Patent No. 6,134,548 to Gottsman et al. (hereinafter "Gottsman"). The rejection is respectfully traversed.

To the extent that it has been authenticated as described above, Current Checks fails entirely to disclose, teach or suggest that for which it is relied upon in the rejection. For this reason, the entire rejection is inappropriate.

To be fully responsive to the outstanding rejection, Applicants note that with respect to Rubber Stamp, the Office Action alleges Rubber Stamp has an e-mail receiver that receives e-mails from different customers.

It appears to Applicants that the customer information is entered on the Rubber Stamp website, which may or may not involve using an e-mail server to receive that information. Because Rubber Stamp does not explicitly disclose using an e-mail receiver that receives e-mails from different customers, it may not do so. While it is possible that Rubber Stamp may provide such a feature, in view of the fact that a sender of e-mails can include customer and

product request information in an e-mail, it may not, and a rejection based on inherency requires that what is alleged to be disclosed is necessarily disclosed. Under the doctrine of inherency, if an element is not expressly disclosed in a prior art reference, the reference will still be deemed to anticipate a subsequent claim if the missing element "is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Cont'l Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749(Fed. Cir. 1991). "Inherent anticipation requires that the missing descriptive material is 'necessarily present,' not merely probably or possibly present, in the prior art." Trintec Indus., Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599(Fed. Cir. 2002) (quoting In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)). Because this claimed feature of using an e-mail receiver that receives e-mails from different customers may not exist in Rubber stamp, the rejection based on Rubber Stamp is not proper.

Nor does Rubber Stamp explicitly indicate that it sends an acknowledgement of receipt of the e-mail regarding each request to each customer, either in general, or based on the customer information. Rubber Stamp discloses a blank space for a customer to provide the customer e-mail address. This definitely does not disclose the acknowledgement feature in the claims.

Rubber Stamp also does not disclose the claimed electronic data analyzer that analyzes contents of each piece of e-mail received by the e-mail receiver and electronically converts the e-mail data on the requested personalized product to electronic image data to be outputted to an output medium.

The assertion that Rubber Stamp discloses this feature is sheer speculation. The claimed data analyzer is an inanimate object, not a human being, as denoted by use of "that" instead of "who" in the claim. Moreover, as amended, claim 1 recites that the data analyzer is an electronic data analyzer. Claim 12 recites a computerized system that includes a data

analyzer that electronically analyzes each piece of personalized product producing data in the first format and converts it to a piece of data in a second format; and a personalized product producing device that receives the piece of data in the second format converted by the data analyzer and electronically records the piece of data in the second format on an output medium to produce a personalized product. Method claim 13 contains a number of similar features. This rules out the speculation in the Office Action that "a worker" looks at the contents of the e-mails and converts the data into an image to be created.

Furthermore, creating data into an image is speculation, because the actual method(s) used to create the stamp are nowhere disclosed in Rubber Stamp. It is well settled that an Office Action must be based on facts, not on speculation. Additionally, claim 1 recites a personalized product producing device that receives the electronic image data and outputs an image to the output medium. There is no disclosure in Rubber Stamp of such a feature.

Rubber Stamp admittedly does not disclose use of wireless communication.

Current Checks is alleged to teach that it is known to use a feedback service that, when a person sends an e-mail (page 10), the system sends an e-mail to its customer to confirm that the order was received and another to confirm that the product is completed (page 6).

Applicants respectfully disagree. Current Checks, on page 10, only discusses a "response to your message" and does not mention a "confirmation." Current Checks does state, on page 5, that a user may send an e-mail to "feedback@currentchecks.com", and states, on page 4, that an e-mail confirmation is sent within 24 to 48 hours after the order was placed. Current Checks never states whether the confirmation is just of order placement or of order completion or both. Current Checks also mentions "double confirmation" on page 5, but provides no detail about what is confirmed in the sense of order receipt or order

completion or both. Accordingly, neither Rubber Stamp nor Current Checks appears to disclose sending an email to notify the customer of completion of the order.

Gottzman discloses using wireless devices to send and receive e-mails. Gottzman fails to disclose the use of e-mails in the context of the claimed invention, however, and fails to disclose the features missing from the Rubber Stamp reference and the Current Checks reference.

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 1-6 and 10-17 under 35 U.S.C. §103(a) as being unpatentable over Rubber Stamp in view of Current Checks and further in view of Gottzman be withdrawn.

In paragraph 10 on page 7, the Office Action rejects claims 5 and 7-9 under 35 U.S.C. §103(a) as being unpatentable over Rubber Stamp in view of Current Checks, Gottzman and further in view of U.S. Patent No. 5,732,398 to Tagawa. This rejection is respectfully traversed.

This rejection is improper based at least for the reasons stated above regarding the Rubber Stamp - Current Checks - Gottzman reference combination.

Moreover, to the extent that it has been authenticated as described above, Current Checks fails entirely to disclose, teach or suggest that for which it is relied upon in the rejection. For this reason, the entire rejection is inappropriate.

Tagawa adds nothing to the aforementioned reference combination other than the fact that it is a disparate reference directed to a self-service system for selling travel related services or products. It is not the type of reference that one of ordinary skill in the art would be motivated to use to modify the base reference combination of three references, none of which are directed to selling travel related services. In fact, it is evidence of the improper hindsight reconstruction of Applicants' invention based solely on Applicants' disclosure.

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 5 and 7-9 under 35 U.S.C. §103(a) as being unpatentable over Rubber Stamp in view of Current Checks, Gottsman and further in view of Tagawa be withdrawn.

In paragraph 11 on page 8, the Office Action rejects claims 1-6 and 10-17 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,801,944 to Kara in view of Current Checks and further in view of Gottsman. This rejection is respectfully traversed.

To the extent that it has been authenticated as described above, Current Checks fails entirely to disclose, teach or suggest that for which it is relied upon in the rejection. For this reason, the entire rejection is inappropriate.

Kara is a word processor based system which a user controls to create a personalized postage indicia. Kara lacks several fundamental claimed features of the invention, including (1) an electronic mail (e-mail) receiver that can receive pieces of e-mail from each customer, by wireless communication, each piece of e-mail containing data on a requested personalized product along with customer information; (2) an e-mail returning device that returns, upon receipt of each piece of e-mail by the e-mail receiver, a piece of e-mail for acknowledging receipt of each request to each of the customers, based on the customer information; (3) an electronic data analyzer that analyzes contents of each piece of e-mail received by the e-mail receiver and electronically converts the e-mail data on the requested personalized product to electronic image data to be outputted to an output medium; (4) a personalized product producing device that receives the electronic image data and outputs an image to the output medium; and (5) an e-mail transmitter that transmits a piece of e-mail for notifying each of the customers of completion of production of the requested personalized product by the personalized product producing device.

The deficiencies in Current Checks are discussed above.

There would be no incentive for one of ordinary skill in the art to drastically reconfigure and redesign Kara to include the e-mail features recited in the claims.

Gottzman discloses using wireless devices to send and receive e-mails. Gottzman fails to disclose the use of e-mails in the context of the claimed invention, however, and fails to disclose the features missing from Kara and the Current Checks references.

Moreover, with respect to claims 4 and 10, as agreed to in the Interview, and as reflected in the Examiner's Interview Summary, claims 4 and 10 are considered allowable over the applied art of record.

For at least the foregoing reason, it is respectfully requested that the rejection of claims 1-6 and 10-17 under 35 U.S.C. §103(a) as being unpatentable over Kara in view of Current Checks and further in view of Gottzman be withdrawn.

In paragraph 12 on page 10, the Office Action rejects claims 5 and 7-9 under 35 U.S.C. §103(a) as being unpatentable over Kara in view of Current Checks, Gottzman and further in view of Tagawa. This rejection is respectfully traversed.

To the extent that it has been authenticated as described above, Current Checks fails entirely to disclose, teach or suggest that for which it is relied upon in the rejection. For this reason, the entire rejection is inappropriate.

The Kara-Current Checks-Gottzman reference combination fails to render the claimed invention obvious at least for the reasons stated above.

Tagawa adds nothing to the aforementioned reference combination other than the fact that it is a disparate reference directed to a self-service system for selling travel related services of products. It is not the type of reference that one of ordinary skill in the art would be motivated to use to modify the base reference combination of three references, none of which are directed to selling travel related services. In fact, it is evidence of the improper hindsight reconstruction of Applicants' invention based solely on Applicants' disclosure.

For at least the foregoing reason, it is respectfully requested that the rejection of claims 5 and 7-9 under 35 U.S.C. §103(a) as being unpatentable over Kara in view of Current Checks, Gottsman and further in view of Tagawa be withdrawn.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-17 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Further, should the Examiner resubmit the rejections in a subsequent Office Action with sufficient documentation to properly substantiate a prior art publication date alleged for the reference(s) in the Notice of References cited, it is respectfully submitted that such an Office Action cannot properly be made final.

Respectfully submitted,



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JAO:RJW/sxb

Attachment:
Replacement Sheet

Date: December 29, 2003

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